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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,726	08/05/2003	Paul L. Jeran	10982225-2	8866

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EXAMINER

WALLERSON, MARK E

ART UNIT PAPER NUMBER

2626

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/635,726

Applicant(s)

JERAN ET AL.

Examiner

Mark E. Wallerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/5/2003</u> . | 6) <input type="checkbox"/> Other: ____.  |

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**Part III DETAILED ACTION**

**Notice to Applicant(s)**

1. This application has been examined. Claims 1-19 are pending.

***Information Disclosure Statement***

2. The references listed in the Information Disclosure Statement dated 8/5/2003 have been considered by the Examiner and is attached to this Office Action.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 6, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolff et al (Wolff) (U.S. 5,671,282).

With respect to claims 1 and 6, Wolff discloses a method of document management, comprising providing a document (column 3, lines 27-29); scanning the document with a scanning machine configured to determine if the document has a machine-readable code thereon', the scanning machine being further configured to extract at least some information from the machine-readable code if the machine readable code is present on the document (column 5, lines 4-24); providing a database of information that can be present in the machine- readable code on the document (column 3, lines 41-43 and column 3, line 65 to column 4, line 15), and

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comparing at least some of any information extracted from the machine- readable code by the scanning machine with the information in the database to track the document (column 3, lines 43-64).

With regard to claim 2, Wolff discloses printing the document with a printing device which prints the machine-readable code on the document, and wherein the printing device is in data communication with the database (column 4, lines 16-34).

With respect to claim 16, Wolff discloses the scanning machine is linked with a processor (101B) that is in data communication with the database (101A) and in data communication with a second printer (101D), wherein the information contained in the machine-readable code defines a version of the document (column 4, lines 16-28), wherein a digital representation of the scanned version of the document is stored on the database together with digital representations of other versions of the document (column 3, lines 35-50), and wherein the processor is configured to determine that electronic representations of the other versions of the document are in the database (column 3, lines 35-50), the processor being configured to enable either the scanned version of the document or at least one of said other versions of the document stored in the database as digital representations to be printed by the second printer (column 3, line 35 to column 4, line 34).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 4, 5, 7, 8, 9, 10, 12, 13, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff in view of Ikenoue et al (Ikenoue) (U.S. 5,987,127).

With respect to claims 3, 4, 7, 8, and 9, Wolff differs from claims 3, 4, 7, 8, and 9, in that he does not clearly disclose wherein the scanning machine is linked with a copying machine configured for copying the document, wherein the information contained in the machine-readable code defines if the document can be copied, and wherein the copier is configured to copy the document unless the scanning machine finds the machine-readable code on the document and extracts information from the machine-readable code not authorizing the copying.

Ikenoue discloses an image forming apparatus and copy management system wherein a scanning machine is linked with a copying machine configured for copying a document, wherein the information contained in machine-readable code defines if the document can be copied, and wherein the copier is configured to copy the document unless the scanning machine finds the machine-readable code on the document and extracts information from the machine-readable code not authorizing the copying (column 2, lines 45-56; column 10, lines 24-67, and column 11, lines 35-48). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Wolff wherein the information contained in machine-readable code defines if the document can be copied, and wherein the copier is configured to copy the document unless the scanning machine finds the machine-readable code on the document and extracts information from the machine-readable code not authorizing the copying. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified

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Wolff by the teaching of Ikenoue in order to prevent illegal copying as disclosed by Ikenoue in column 1, lines 12-15.

With regard to claim 5, Wolff discloses the information included in the machine-readable code includes a version number of the document (column 4, lines 23-28).

With respect to claim 10, Wolff discloses the machine-readable code is printed with at least one of a resolution or tonal (density) difference that cannot be reproduced by the second copying machine (column 8, lines 18-36).

With regard to claims 12 13, and 14, Wolff discloses printing the code on copies of the document (column 4, lines 16-34).

With respect to claim 15, Wolff differs from claim 15 in that he does not clearly disclose the second copying machine is configured to identify a user requesting a copy of the document, wherein the information contained in the machine-readable code defines if the document can be copied by particular users, and wherein the second copying machine is configured to not copy the document unless the scanning machine finds the machine-readable code and extracts information from the code authorizing copying by an identified user.

Ikenoue discloses identifying a user requesting a copy of the document, wherein the information contained in the machine-readable code defines if the document can be copied by particular users, and wherein the second copying machine is configured to not copy the document unless the scanning machine finds the machine-readable code and extracts information from the code authorizing copying by an identified user (column 2, lines 46-56). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Wolff wherein the information contained in the machine-readable code defines if the

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document can be copied by particular users, and wherein the second copying machine is configured to not copy the document unless the scanning machine finds the machine-readable code and extracts information from the code authorizing copying by an identified user. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Wolff by the teaching of Ikenoue in order to prevent illegal copying.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff in view of Ikenoue as applied to claim 9 above, and further in view of Jeran et al (Jeran) (U.S. 6,628,412).

With respect to claim 11, Wolff as modified differs from claim 11 in that he does not clearly disclose the machine-readable code is printed with an ink that is not visible when viewed with only light in the visible wavelength range, said ink becoming visible when stimulated with light outside of the visible wavelength range.

Jeran discloses a document management method machine-readable code is printed with an ink that is not visible when viewed with only light in the visible wavelength range, said ink becoming visible when stimulated with light outside of the visible wavelength range (column 3, lines 9-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Wolff as modified wherein the machine-readable code is printed with an ink that is not visible when viewed with only light in the visible wavelength range, said ink becoming visible when stimulated with light outside of the visible wavelength range. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Wolff as modified by the teaching of Jeran in order to easily hide the machine readable image as disclosed by Jeran in column 3, lines 3-5.

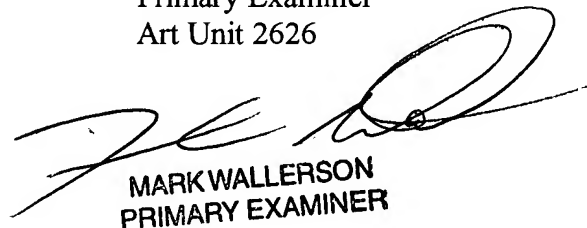
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (571) 272-7470. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson  
Primary Examiner  
Art Unit 2626



MARK WALLERSON  
PRIMARY EXAMINER